

REMARKS

In an Office Action mailed on May 22, 2002, claims 2, 3, 14, 31 and 33 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite; claims 1-11, 13-25, 27-41 and 43-45 were rejected under 35 U.S.C. § 102(b) as being anticipated by Heaford; and claims 12, 26 and 42 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Heaford in view of Grindle. Claims 2, 3, 31 and 33 have been amended to overcome the corresponding § 112 rejections. The remaining § 112 rejection of claim 14 along with the §§ 102 and 103 rejections are discussed below in the corresponding sections. Newly added claims 46-56 are patentable over the cited art.

The undersigned requests a telephonic interview with the Examiner after the Examiner has reviewed this Reply.

A marked-up version of the amended claims is submitted as a separate document. The undersigned has endeavored to ensure that the clean and marked-up versions of the amended claims correspond. However, the Examiner is specifically requested to verify that these two versions of the claims are consistent.

§ 112 Rejection of Claim 14:

The Examiner rejects claim 14 under 35 U.S.C. § 112 for being indefinite for allegedly not positively claiming the eyeglass frames in claim 1. However, claim 14 does not claim the bridge as an element but rather claims a property of the first fastener, i.e., the fastener is adapted to attach the flexible body to the bridge. Thus, without a specific basis for sustaining the § 112 rejection, withdrawal of the § 112 rejection of claim 14 is requested.

§§ 102 and 103 Rejections:

The eye patch of claim 1, the assembly of claim 16, the eye patch of claim 30, the assembly of claim 34 and the eye patch of claim 39 each includes a flexible body to be positioned on a front of eyeglass frames to substantially block both frontal and peripheral vision of an eye.

Contrary to the limitations set forth by these independent claims, Heaford neither teaches nor suggests a flexible body that substantially blocks both frontal and peripheral vision of an eye.

In this manner, the eye protector disclosed by Heaford is, by definition, made from a material that does not substantially block vision (frontal or peripheral vision) of an eye. Thus, Heaford does not teach all of the limitations of any of the independent claims.

In the Office Action, the Examiner states, "the method of intended use is not given patentable weight in the article claims." However, this is clearly improper. As stated by the Federal Circuit, it is improper to delete functional language from a claim in performing an invalidity determination under Section 102. *Pac-tec, Inc. v. Amerace Corp.*, 14 USPQ2d 1871, 1876 (Fed. Cir. 1990). The *Pac-tec* court rejected a construction of claims that eliminated functional limitations so that the claims were reduced to a near collection of parts. *Id.* That is exactly what the Office Action is attempting to do, namely, ignore specific recitation of elements in the claim so that the claim is in effect a collection of parts.

When the independent claims are properly construed and expressly recited words of the claim are given the weight that they are due, Heaford neither teaches nor suggests all of the limitations of these claims.

Thus, for at least these reasons, withdrawal of the rejections of claims 1-45 in view of Heaford is requested.

CONCLUSION

In view of the foregoing, withdrawal of the §§ 112, 102 and 103 rejections and a favorable action in the form of a Notice of Allowance are requested. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 20-1504 (GIJ.0002US).

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Respectfully submitted,

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APPENDIX

The claims have been amended as follows:

2. (Amended) The eye patch of claim 1, wherein
[the eyeglass frames comprises a lens socket, and]
the body is adapted to at least partially extend over a [the] lens socket of the eyeglass frames.
3. (Amended) The eye patch of claim 1, wherein
[the eyeglass frames holds a lens, and]
the body is adapted to at least partially extend over a [the] lens of the eyeglass frames.
31. (Amended) The eye patch of claim 30, wherein
[the eyeglass frames comprises a lens socket, and]
the body is adapted to at least partially extend over a [the] lens socket of the eyeglass frames.
33. (Amended) The eye patch of claim 30, wherein
[the eyeglass frames comprise a side arm and a bridge, and]
at least one fastener comprises:
 - a first fastener to attach the eye patch to a [the] bridge of the eyeglass frames; and
 - a second fastener to attach the eye patch to a [the] side arm of the eyeglass frames.